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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of	:	Gupta et al.
Serial No	:	09/747,647
Filed	:	December 22, 2000
For	:	Method and Apparatus for Reporting the Status of Work in Progress
Group Art No.	:	3627
Examiner	:	Gort, E.

CERTIFICATION UNDER 37 CFR 1.8(a) and 1.10

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Date: September 19, 2007 /Robyn L. Templin/
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REPLY BRIEF RESPONSIVE TO EXAMINER'S ANSWER MAILED JULY 19, 2007

Dear Sir:

This Reply Brief is being filed in response to the Examiner's Answer mailed July 19, 2007.

REPLY BRIEF

Claims 1-21 stand rejected in the present application. Claims 15-21 stand rejected under 35 U.S.C. §101. Claims 1-21 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Martin et al. (USP 5,809,479) in view of Dietrich et al. (USP 6,032,121) and further in view of Schoenberg et al. (USP 6,322,502). In the Examiner's Answer mailed July 19, 2007, the Examiner withdrew the rejection of claim 4 under 35 U.S.C. §112, second paragraph. The Examiner maintained the rejection of claims 1-21 under 35 U.S.C. §103(a) and the rejection of claims 15-21 under 35 U.S.C. §101 and dismissed all of the arguments in regards to these claims that were set forth by Appellant in the Appeal Brief of March 12, 2007. In this Reply, Appellant would like to address some of the assertions made by the Examiner.

I. Rejection under 35 U.S.C. §101

In section **(10) Response to Argument** of the Examiner's Answer, the Examiner rejected arguments previously set forth by the Appellant regarding the rejection of claims 15-21 under 35 U.S.C. §101. The Examiner stated that "these claims are directed to non-statutory subject matter reciting logic per se" and that "the descriptions or expressions of the programs, are not physical 'things'." Examiner's Answer, July 19, 2007, p. 3-4 (citing, in part, MPEP 2106(IV)(B)(1)(a)). Appellant respectfully disagrees with the Examiner's conclusion that claim 15 is directed to non-statutory subject.

First, it is noted that, as previously stated by the Examiner, the computer data signal called for in claim 15 is a "data structure." As the computer data signal called for in claim 15 is a "data structure," it falls within one of the four enumerated categories of statutory subject matter as a manufacture or composition of matter. Thus, claim 15 constitutes patentable subject matter so long as it has a practical utility. See MPEP §2106(IV)(B).

Second, the Examiner has failed to show that claim 15 lacks a practical utility, as is required to show a *prima facie* case of unpatentability. In fact, this is clearly not the case, as the computer data signal called for in claim 15 represents a sequence of instructions that, when executed by one or more processors, causes the one or more

processors to execute a plurality of acts. That is, the computer data signal causes the one or more processors to, in part, populate a database, query the database, set a proactive alert, set a reactive alert, and display all proactive and reactive alerts, thus providing a practical utility. In light of the foregoing, Appellant believes that claims 15-21 are directed to statutory subject matter and therefore believes the rejection under §101 to be improper.

II. Rejection under 35 U.S.C. §103(a) over Martin et al. in view of Dietrich et al. and further in view of Schoenberg et al.

In section **(10) Response to Argument** of the Examiner's Answer, the Examiner dismissed Appellant's arguments previously set forth regarding the rejection of claims 1-21 under 103(a) over Martin et al. in view of Dietrich et al. and further in view of Schoenberg et al., in which Appellant had argued that: there is no motivation to combine the cited references, the combination of the cited references does not provide a reasonable expectation of success in achieving the current invention, and the cited references fail to teach or suggest all the elements of the claims.

1. Lack of Motivation to Combine References

Regarding the lack of motivation to combine Martin et al., Dietrich et al., and Schoenberg et al., the Examiner stated that "KSR forecloses Appellant's argument that a specific teaching is required for a finding of obviousness." Examiner's Answer, supra at 4. The Examiner further stated that the claims "recite combinations which only unite old elements with no change in their respective functions and which yield predictable results" and that "[t]hus, the claimed subject matter likely would have been obvious under KSR." *Id.* at 4-5.

While Appellant is mindful of the decision in *KSR Int'l Co. v. Teleflex Inc.*, No. 04-1350 slip op. (U.S. April 30, 2007), Appellant believes that the Examiner has still not met the burden for showing a teaching, suggestion, or motivation to combine the cited references. That is, while the holding in *KSR* supports an expansive and flexible approach for showing the requisite teaching, suggestion, or motivation in determining

obviousness, the Examiner still must identify the reason(s) why a person of ordinary skill in the art would have combined the prior art elements in the manner claimed. *See PTO Memo* dated May 3, 2007 from Margaret A. Focarino to Technology Center Directors (copy attached). In the present case, the Examiner has failed to do such, and in fact, the disclosures of the cited references teach away from such a combination.

As explained in detail by Appellant in the Appeal Brief of March 12, 2007, there would be no motivation to combine the cited references because the Examiner's combination of Dietrich et al. with Martin et al. would require that the system of Martin et al. not perform as intended. Furthermore, the combination of Schoenberg et al. with Martin et al. and Dietrich et al. would require that those systems also not perform as intended. As stated in MPEP §2143.01.V, "if a proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification." The Examiner cannot merely ignore the clear teachings of the cited references and simply state that "KSR forecloses Appellant's argument that a specific teaching is required for a finding of obviousness," but rather must set forth the reason(s) why a person of ordinary skill in the art would have combined the prior art elements in the manner claimed.

2. Lack of Reasonable Expectation of Success in Achieving the Current Invention

Regarding the expectation of success in achieving the current invention by combining Martin et al., Dietrich et al., and Schoenberg et al., the Examiner stated that "[t]he combining of Dietrich's clearly discloses 'proactive' alerts and Schoenberg's distinguishment by product category and 'reactive' alerts to Martin et al.'s method of comparing, generating and routing to a human order scheduler… is straightforward and one of ordinary skill in the art at the time of the invention would have been able to combine these references to produce the claimed method." Examiner's Answer, supra at 6. Appellant respectfully disagrees.

The combination of the cited references simply would not result in a system as called for in claims 1, 9 and 15. First, the systems of Dietrich et al. and Martin et al. are variants of one another. They each address delivery performance either through

proactive plan generation, as in Dietrich et al., or result orientated analysis, such as the system of Martin et al. If operation in accordance with the system of proactive planning of Dietrich et al. were feasible, it would render the on-time performance system of Martin et al. useless. That is, by always having a newly generated plan schedule, Dietrich et al. schedules planning events to attempt to prevent missed shipments and Martin et al. monitors and tracks on-time delivery performance. Dietrich et al. suggests scheduling a new scheduling event when a plan cannot be satisfied, whereas Martin et al. teaches notifying users of late deliveries for gauging on-time delivery performance. The combination thus defeats the purpose of the reference.

The addition of Schoenberg et al. with Martin et al. and Dietrich et al. does not correct the deficiencies of the combination of Martin et al. and Dietrich et al. or add to the expectation of success in achieving the current invention. That is, if an alert is generated for every order of Martin et al., as suggested by the preset mechanical reminders of Schoenberg et al., then, after the scheduler of Martin et al. reviews the orders and after he moves an order so that the promise date is later than a request date, the system would then immediately generate an alert, according to Schoenberg et al., to alert the very scheduler who moved the data just seconds before. Since the scheduler already knows that the delivery date is after the customer-requested delivery date, the scheduler does not need an alert and, in fact, it would hinder his performance by requiring that he now must clear an alert of the condition he just created. That is, the combination of the disclosures of the references would provide a system where "alerts" are generated for ordinary action items. A person of ordinary skill in the art would readily appreciate that indications of normal operational conditions are not alerts. Furthermore, combining the reminder of Schoenberg et al. with the tracking system of Martin et al. and the planning system of Dietrich et al. results in a system where planning events are intermittently scheduled and non-satisfaction of a planning event is recorded and reported to a customer. Such a system is not what is presently claimed, and such a system is incapable of achieving the benefits of the present system.

3. References do not Teach, Disclose, or Suggest All the Elements of the Present Claims

Claim 1

The Examiner reiterated that the combination of Martin et al., Dietrich et al., and Schoenberg et al. teaches all the elements of claim 1, stating in part that "Dietrich et al.'s 'proactive promise alerts' [ ] provide specific advance warnings to reduce the chance that undesired events will occur" and that the combination of Martin et al. and Dietrich et al. displays the proactive promise alerts and order numbers for those given orders that have a promise date that is later than their respective request date. *See* Examiner's Answer, supra at 8-9.

As previously set forth by Appellant, the system of Dietrich et al. does not set a proactive promise alert for orders having a promise data later than a request date. Rather, Dietrich et al. calls for generating a new plan if an event is not satisfiable by the current plan and states that "a proactive planning methodology can use information about changes in the input data used for planning to determine when a next plan should be produced." Dietrich, et al., Col. 2, ln. 66 to Col. 3, ln. 2. Claim 1 does not call for scheduling or conducting a planning event as disclosed by Dietrich et al, but calls for setting a proactive alert if a promise date is later than a request date for a specific order and displaying alerts with the order numbers for those orders that have a promise date that is later than their respective request date. That is, the method of claim 1 both identifies and displays those orders which cannot be delivered according to a present schedule. The system of Dietrich et al. indicates that a schedule needs to be generated and does not isolate and display those orders which have the potential of being delivered late as called for in claim 1.

Claim 9

Similar to claim 1, the Examiner reiterated that the combination of Martin et al., Dietrich et al., and Schoenberg et al. teaches all the elements of claim 9, stating again that Dietrich et al. teaches the use of proactive planning alerts, and additionally that Shoenberg et al. teaches reactive alerts when orders have not been delivered and they are scheduled to be delivered. As set above with respect to claim 1, the system of Dietrich et al. does not set a proactive promise alert for orders having a promise data later than a

request date, but instead calls for generating a new plan if an event is not satisfiable by the current plan by using information about changes in the input data used for planning to determine when the next plan should be produced. Additionally, as the proactive activity of Dietrich et al. is to generate a schedule plan, there is no proactive alert associated with any order as presently claimed. Accordingly, the art of record fails to teach or suggest a proactive alert as claimed or a reactive alert as claimed.

In regards to Schoenberg et al., Appellant does not necessarily disagree that it teaches the use of reactive alerts. However, Schoenberg et al. does not teach or suggest a reactive alert that is set and displayed if the shipment date exists and the request date is less than a user-defined number of days prior to a current date, as is called for in claim 9. As stated by Schoenberg et al., the alarm disclosed therein is generated and displayed after a medication time has been missed. Furthermore, as the art of record fails to teach or suggest the alerts as claimed, there is no disclosure in the art of record that teaches or suggests displaying a type of alert as called for in claim 9.

Claim 15

The Examiner asserted that the combination of Martin et al., Dietrich et al., and Schoenberg et al. teaches all the elements of claim 15, stating again that Dietrich et al. teaches the use of proactive planning alerts, and additionally that Shoenberg et al. teaches reactive alerts when orders have not been delivered and they are scheduled to be delivered. As argued above with respect to claim 9, Dietrich et al. does not set a proactive promise alert for orders having a promise data later than a request date, but instead calls for generating a new plan if an event is not satisfiable by the current plan by using information about changes in the input data used for planning to determine when the next plan should be produced. Furthermore, Schoenberg et al. does not teach or suggest a reactive alert that is set and displayed if the shipment date exists and the request date is less than a user-defined number of days prior to a current date, as is called for in claim 15. Thus, the cited references fail to teach or suggest these claimed elements, and additionally, fail to teach or suggest displaying the proactive and reactive alerts by product/service category and type of alert, as further called for in claim 15.

For all these reasons, Appellant believes that the combination of Martin et al., Dietrich et al., and Schoenberg et al. fails to teach all of the elements in each of claims 1, 9 and 15.

Thus, in view of the above remarks, Appellant respectfully submits that the Examiner has provided no supportable position or evidence that claims 1-21 are obvious under 35 U.S.C. §103(a). Accordingly, Appellant respectfully requests that the Board find claims 1-21 patentable over the prior art of record, direct withdrawal of all outstanding rejections, and direct the present application be passed to issuance.

Respectfully submitted,

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MEMORANDUM

DATE: **May 3, 2007**

TO: **Technology Center Directors**

Margaret A. Focarino

FROM: **Margaret A. Focarino**
Deputy Commissioner
for Patent Operations

SUBJECT: **Supreme Court decision on *KSR Int'l. Co., v. Teleflex, Inc.***

The Supreme Court has issued its opinion in *KSR*, regarding the issue of obviousness under 35 U.S.C. § 103(a) when the claim recites a combination of elements of the prior art. *KSR Int'l Co. v. Teleflex, Inc.*, No 04-1350 (U.S. Apr. 30, 2007). A copy of the decision is available at http://www.supremecourtus.gov/opinions/06pdf/04-1350.pdf. The Office is studying the opinion and will issue guidance to the patent examining corps in view of the *KSR* decision in the near future. Until the guidance is issued, the following points should be noted:

(1) The Court reaffirmed the *Graham* factors in the determination of obviousness under 35 U.S.C. § 103(a). The four factual inquiries under *Graham* are:

(a) determining the scope and contents of the prior art;
(b) ascertaining the differences between the prior art and the claims in issue;
(c) resolving the level of ordinary skill in the pertinent art; and
(d) evaluating evidence of secondary consideration.

Graham v. John Deere, 383 U.S. 1, 17-18, 148 USPQ 459, 467 (1966).

(2) The Court did not totally reject the use of "teaching, suggestion, or motivation" as a factor in the obviousness analysis. Rather, the Court recognized that a showing of "teaching, suggestion, or motivation" to combine the prior art to meet the claimed subject matter could provide a helpful insight in determining whether the claimed subject matter is obvious under 35 U.S.C. § 103(a).

(3) The Court rejected a rigid application of the "teaching, suggestion, or motivation" (TSM) test, which required a showing of some teaching, suggestion, or motivation in the prior art that would lead one of ordinary skill in the art to combine the prior art elements in the manner claimed in the application or patent before holding the claimed subject matter to be obvious.

(4) The Court noted that the analysis supporting a rejection under 35 U.S.C. § 103(a) should be made explicit, and that it was "important to identify a reason that would have prompted a person of ordinary skill in the relevant field to combine the [prior art] elements" in the manner claimed. The Court specifically stated:

> Often, it will be necessary . . . to look to interrelated teachings of multiple patents; the effects of demands known to the design community or present in the marketplace; and the background knowledge possessed by a person having ordinary skill in the art, all in order to determine whether there was an **apparent reason** to combine the known elements in the fashion claimed by the patent at issue. To facilitate review, this analysis **should be made explicit**.

KSR, slip op. at 14 (emphasis added).

Therefore, in formulating a rejection under 35 U.S.C. § 103(a) based upon a combination of prior art elements, it remains necessary to identify the reason why a person of ordinary skill in the art would have combined the prior art elements in the manner claimed.